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**JUN 07 2006**

**OFFICE OF PETITIONS**

In re Application of :  
Silfverberg, et al. :  
Application No. 09/944,165 : PATENT TERM ADJUSTMENT  
Filed: September 4, 2001 :  
Dkt. No.: 004770.00018 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed April 14, 2006. This matter is being treated as a timely filed application for patent term adjustment under 37 CFR 1.705(b).

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is HELD-IN ABEYANCE UNTIL AFTER THE PATENT ISSUES.

If Applicants' disagree with the determination at the time of the of the issuance of the patent, they can request that the Office reconsider the determination within two months of the issuance of the patent. If the sole reason for the request for reconsideration of the PTA determination is the 3-year rule, then applicant can have the PTA determination reviewed without an additional fee.

The correct PTA at the time of the allowance is 242 days.

The Determination of Patent Term Adjustment under 35 USC 154(b), mailed March 8, 2006, indicated a PTA to date of 242 days.

Applicants request that the Determination of Patent Term Adjustment be corrected from 242 days to include an unspecified period of adjustment that encompasses the period of pendency of the application beyond three years. Applicants have not contested the period of adjustment totaling 271 days or the reduction of 26 days for applicants' failure to engage in reasonable efforts to conclude prosecution. Applicants further assert that there was no further failure to engage in reasonable efforts to conclude prosecution by applicants.

Applicants are advised that knowledge of the actual date the patent issues is required to calculate the amount of additional patent term, if any, for Office failure to issue the patent

within three years. See, 37 CFR 1.703(b). Thus, applicants' request for reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date of the application is being **held in abeyance** until after the actual patent date.

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B) (and 37 CFR 1.704(b)), the entire period during which the application was pending (except for periods excluded under 35 USC 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 USC 154(b)(1)(B) in determining whether periods of delay overlap under 35 USC 154(b)(2)(A). Thus, any days of delay for Office issuance of the application that overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See, 35 USC 154(b)(1)(B), 35 USC 154(b)(2)(A), and 37 CFR 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Red. Reg. 21704 (April 22, 2004).

The adjustment of 271 days is reduced three days in accordance with 37 CFR 1.704(c)(8) in connection with the Information Disclosure Statement (IDS) submitted July 29, 2004. The reduction began December 16, 2003, the day after the date that the initial reply was submitted, and ended July 29, 2004, the date the supplemental reply (IDS) was submitted.

The adjustment of 271 days is further reduced 26 days, as acknowledged by applicants in accordance with 37 CFR 1.704(b).

Accordingly, at the time of mailing of the notice of allowance, the application is entitled to an adjustment of 242 days as determined. The adjustment of 271 days is properly reduced 29 days in accordance with 37 CFR 1.704

The Office acknowledges receipt of the required fee of \$200.00 for an application for patent term adjustment.

This application is being directed to the Office of Patent Publication for further processing. Any delays in issuing the patent pursuant to 37 CFR 1.702(a)(4) will be reflected in the determination that is mailed to applicants in the issue notification letter approximately three weeks prior to issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

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